

REMARKS

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

Claims 1-11 and 15-23 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement, and containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1, 15, and 17 recite that the method includes directly viewing the at least one paint layer at an acute angle to the object surface without use of an ultraviolet light "and without use of any intermediary layer between a viewer and the at least one paint layer," such that the unique discrete identification created by fluorescent material migrated into the at least one paint layer is visible at an acute angle to the object surface without the ultraviolet light "and any intermediary layer between the viewer and the at least one paint layer," while being substantially invisible at an angle normal to the object surface. Claim 19 is similar, and includes the term "between a viewer and the embedded marking fluid on the vehicle surface." Support is found in the drawings in Fig. 8 and in the specification at paragraph 0044 where the top paint layer is directly viewed 68 at an acute angle without any intermediary layer between a viewer and the paint layer.

In *Ex parte Parks*, 30 USPQ2d 1234 (BPAI 1993), the application claims were rejected under 35 USC § 112, first paragraph, for not supporting the claim term "in the

absence of a catalyst." In reversing the rejection, the Board noted that "the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112." *Id.* at 1236 (citing *In re Herschler*, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 196 USPQ 465 (CCPA 1978) and *In re Wertheim*, 191 USPQ 90 (CCPA 1976)). In reviewing the description given in the application, the Board also noted that "[T]hroughout the discussion [of the method], which would seem to cry out for a catalyst if one were used, no mention is made of a catalyst." *Id.* The Board concluded that the originally filed disclosure conveyed to one of ordinary skill in the art that the inventors had possession of the concept of conducting the method in the absence of a catalyst.

Likewise, in the instant application the discussion in paragraph 0044 and Fig. 8 clearly convey to the reader that the inventor had possession of the invention as described in the claims. In particular, pointing line 68 in Fig. 8 shows the acute angle of view between the viewer and the surface 58 of paint layer 56, and the absence of any intermediary layer between the viewer and the paint layer. If an intermediary layer were needed, the description in paragraph 0044 and Fig. 8 would "cry out" for one. *Ex parte Parks* at 1236. None is shown, however, confirming to one of ordinary skill in the art that the inventor had possession of the concept that an intermediary layer was neither required nor used.

The case of *In re Reynolds*, 170 USPQ 94 (CCPA 1971) also dealt with a rejection for lack of support under 35 USC § 112, first paragraph. In that case, the Court found that the drawings provided "geometric certainty" and that "a person skilled in the art would suspect that there was some reason for the relationships shown in the drawing and would

not regard such disclosure as accidental or arbitrary." *Id* at 98. The instant application shows in Fig. 8 an acute angle of view between the viewer and the surface of the paint layer, without any intermediary layer between the viewer and the paint layer. As in *Reynolds*, this provides certainty that one of ordinary skill in the art would understand that the absence of an intermediary layer in the drawing actually means that the method of the invention may be practiced "without use of any intermediary layer between a viewer and the at least one paint layer" as described in the claims.

Accordingly, applicant submits that the Examiner has not established a *prima facie* case for lack of adequate descriptive support, and that the originally filed specification and drawings establish that the claims fully comply with the requirements of 35 USC § 112, first paragraph.

It is respectfully submitted that the application is in a condition where allowance of the entire case is proper. Reconsideration and issuance of a notice of allowance are respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter W. Peterson', written over a horizontal line.

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